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24628	7590	07/01/2008		
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			EXAMINER PARKER, FREDERICK JOHN	
			ART UNIT	PAPER NUMBER
			1792	
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			07/01/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/886,886

Applicant(s)

ILKKA, KEN

Examiner

Frederick J. Parker

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 23-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: (1) page 4, [0008], page 6, [0016]; page 7, [017], the basis of the percentages (by wt, vol, molar, etc) are not stated. Appropriate correction is required. Applicants state the basis can be found in the specification and claim 3, version dated 6-21-01. Applicants must have a different version of these papers than the Examiner because in the Examiner's version, the flaw is also present. The Examiner also points out the same objection/ rejection raised in an earlier Examiner's Action resulted in an amendment by Applicants to insert "by volume" which was deemed New Matter by this Examiner in his action dated 7/19/05, and that amendment was subsequently removed since there was no support for that %-age basis.

Claim Objections

2. The amendments in response to the Claim Objections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

Claim Rejections - 35 USC § 112

3. The amendments in response to the 35 USC 112 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections except as repeated below.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 23,24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 24 is vague and indefinite because the basis of the percentages are not cited; further the combination of 60% ink, 40% hardening agent, and an unstated % epoxy make the composition exceed 100% which is impossible. Since the composition cannot be ascertained, for examination any composition will meet the limitation. Applicants citations in the application filed 6-21-01 are not found. Even if the basis was present, Applicants cannot simply read limitations into the claim from the specification. Although claims are read in light of the specification, this is different from reading limitations into a claim having no express basis in the claim in order to narrow the scope of that claim, In re Parter 162 USPQ 541. Amendment to insert basis with proper support from the original filing is required.
- Claim 23 is vague and indefinite because on last line, the meaning of the phrase “long lasting” is indefinite/ undefined given the relative term “long”, and unclear under what conditions it is “long lasting”. Anything can exist for extended times if it never experiences adverse conditions; alternatively, for a vehicle "long lasting" under arid, hot desert environments with sand blasting effects will differ greatly from an environment of being housed in a climate controlled garage. Hence the meaning of the phrase is unclear and not discernable.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 23,25,29,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pryor et al US 4269874 in view of Alden US 4538560 alone or in combination with the Admitted Prior Art (APA) of [003].
8. The “Background...” section of Pryor et al teaches that in manufacturing, e.g. of automotive parts (encompassing any auto part materials without limitation), the parts are “routinely marked” with indicia without limitation to signify good versus bad parts, part type, shift when made, etc which are visible . Marking has traditionally been carried out by means including stamp-type ink/ paint markers (inherently possessing raised ink printing portions which are the “image”) in which ink wets the stamp including raised portions of the image to be transferred onto the part (col. 1, 8-31). Applying the raised inked portions to a part plated with chrome is not taught. However, Alden teaches chrome plated engine valve covers, the chrome plating being applied to brighten the appearance of the engine and enhance worth of the automobile (col. 1, 13-17; col. 2, 46-48) and the part comprising metal and plastic (col. 1, 29-31). While marking the valve cover via ink stamping is not taught, Pryor et al teaches this to be routine for automobile parts, and hence it would have been obvious to the skilled artisan to have

Art Unit: 1792

applied any such markings via ink stamping to signify quality, part type, or any other indicia, logo, etc for a specific automotive part. Further more, the specific logo, indicia, decoration, etc being stamped does not impart patentability because Pryor disclosed that automotive parts are successfully stamped with such images. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability. In re Seid 73 USPQ 431. Applicants admit the limitation “the ink image being....motor vehicle” is known prior art and therefore obvious, see APA [003] as well as Remarks of 12/10/07, page 8, paragraphs 3-4.

The size of ink batches, stamp forming time, and exact composition would have been determined by routine experimentation for any end-use product, per claims 24- 25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the ink stamping method of Pryor et al on the chrome plated part of Alden or any other chrome plated part, because automotive parts are “routinely marked” with indicia, logos, and other designations by ink stamping.

9. Claims 26,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pryor et al US 4269874 in view of Alden US 4538560 and further in view of Reinke et al US 3170393.

Pryor and Alden are cited for the same reasons above. Heating the printed object is not cited. However, Reinke et al teaches the concept of printing inks onto substrates including metal, followed by drying at any suitable temperature between 200-325F (encompassing claim 26) using a suitable heating element to hasten the drying/ curing process of the ink. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

method of Pryor et al in view of Alden by heating the printed metal article as taught by Reinke et al to hasten the drying/ curing process of the ink, and thereby improve the efficiency of the metal printing process. Specific heating times and temperatures, per claim 27, are result-effective variables conventional to a drying process that would have been determined by the skilled artisan by routine experimentation and/ or readily available technical information for any specific ink and printing process (as also admitted by Applicants in Remarks, top page 7 of paper filed 4/28/08), and therefore would not patentably distinguish over the prior art.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pryor et al US 4269874 in view of Alden US 4538560 and further in view of APA.

Pryor and Alden are cited for the same reasons above. Applying a “key-shaped icon” is not cited. However, **Applicants admit the industry applies instructions, safety icons or indicia, and specifically keyhole icons**, such that it would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Pryor et al in view of Alden by applying keyhole icons to appropriate portions of an automobile as it is known and conventional in the prior art.

Response to Arguments

Arguments have been considered.

Applicants arguments on page 6 bridging 7 regarding 35 USC 112 rejection of claim 23 regarding the intended meanings of “predetermined” state preferred specific conditions are cited in the specification and that other conditions of variations in time and temperature may be made; thus time and temperature are construed to be simply optimization by routine experimentation

Art Unit: 1792

for heat v. time, which are cause-effective variables, longer times at lower temperatures may be equivalent to shorter times at higher temperatures.

As to the prior art, the Examiner points out that providing the image be “long lasting” doesn’t impart patentability; this indefinite phrase of uncertain meaning is rejected under 35 USC 112 above, so its not even clear what the limitation means.

Applicants arguments as to specific indicia, logos, etc and their intended use is not convincing; the totality of the prior art teaches such indicia, etc for part type, part quality, any indicia, logo, instructions, safety icons, and specifically keyhole icons. See prior rejections. Simply printing specific examples of what is known to be printed is intended use and does not impart patentability as claims are currently written. Applicants claim that their process does not relate to the choice of ornamentation is simply unsubstantiated allegation, there being no evidence to prove the mechanical effect or advantage considered to constitute patentability as stated by In re Seid 73 USPQ 431.

Applicants allege the Examiner has not considered the requirements of *Graham v. Deere*. Those requirements are: The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This argument is baseless. The Examiner has gone to great lengths to show differences between the claims and prior art, no matter how small the differences may be. He has determined the level of ordinary skill to be a coating/ printing practitioner with experience but minimal educational expertise, as shown by the similarity of prior art to the claims and specification. Clearly one does not utilize a PHD world-class expert while the other utilizes a garage-shop painter! Applicants' allegations do not constitute "objective evidence" but the prior art and admissions of Applicants are, and they have been considered and discussed in detail throughout case prosecution.

As to hindsight reconstruction: In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the nexus between the prior art cited is clear, and utilizes knowledge and insight available to even the more general practitioner. Combination of references is not "picking and choosing", in this case the rejections clearly showing the reader the state of the art and it takes little technical knowledge to judge what would have been obvious variations. Thus Applicants' arguments are not persuasive.

Applicants' flood of case law simply cannot substitute for the fact the Examiner has made a prima facie case of obviousness. There are no "mere conclusory statements" lacking "some rational underpinning to support the legal conclusion of obviousness": only a series of references

Art Unit: 1792

and admissions by Applicants of the known prior art of similar substance and scope to form a prima facie case of obviousness. The reasons are clearly articulated and the motivations unmistakable.

Applicants evoke KSR. Applicants are reminded KSR 82 USPQ2d 1396 also forecloses the argument that a specific teaching, suggestion, or motivation is required to establish a prima facie case of obviousness. KSR establishes that design incentives, market forces, predictability, use of ordinary skill and common sense, and ordinary capabilities or ingenuity of one skilled in the art articulated by the Examiner may be relied upon to support obviousness. KSR further states The combination of familiar elements according to known methods is generally obvious when it does no more than yield predictable results, KSR, 127 Sup. Ct. at 1739, 2007. The latter finding is especially relevant to the instant case: Applicants use a known process known to apply logos, indicia, etc onto specific substrates and then claim the application of specific logos/ indicia (e.g. key shaped), with the outcome predictably being application of a key-shaped logo, regardless of its intended use.

Applicants arguments regarding "long lasting" is unclear since it is unclear what the phrase means and under what conditions the printing is long lasting; suffices to say both prior art and Applicants pad print on automotive parts so its difficult to rationalize a difference to establish patentability.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 1792

Frederick J. Parker
Primary Examiner
Art Unit 1792

/Frederick J. Parker/
Primary Examiner, Art Unit 1792